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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,903	10/30/2001	Cherisse M. Nicastro	TRIRG-01001US0	5789
28554	7590	12/14/2004	EXAMINER	
VIERRA MAGEN MARCUS HARMON & DENIRO LLP 685 MARKET STREET, SUITE 540 SAN FRANCISCO, CA 94105			NGUYEN, CINDY	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/015,903

**Applicant(s)**

NICASTRO ET AL.

**Examiner**

Cindy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 and 41-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 and 41-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 07/19/04.                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

This is in response to amendments filed 07/19/04.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

#### **1. *Information Disclosure Statement***

The information disclosure statement filed on 07/19/04 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Because it has been placed in the application file, and the information referred to therein has been considered as to the merits.

#### **2. *Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**3. Claims 1-4, 7-11, 15-21 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito (US 5761674) provided by Applicant.**

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Regarding claim 1, Ito discloses: An data structure for an asset management system stored in a data store, the asset including a plurality of physical items contained in the asset, the structure comprising: at least a first item specification template (project model) defining a plurality of data fields for an item (col. 5, lines 13-21, Ito);

a plurality of data values comprising an item specification for at least one item; the values provided in the plurality of data fields describing the item (col. 4, lines 32-42, Ito), said data fields including: at least one attribute value ( walls, girder, col. 5, lines 38-44, Ito); at least one component value (col. 4, lines 8-19, Ito).

Regarding claim 9, Ito discloses: A method for constructing data concerning item specifications in a system for managing an asset, the asset including a plurality of items comprising: providing a user data entry interface (col. 4, lines 42-48, Ito); defining at least one item specification template (col. 4, lines 32-43, Ito); receiving a plurality of data values, each value being provided into a data field of said at least one specification template on the interface, wherein the plurality of data values comprise a specification for an item and each data field of the specification describes an attribute of the item (col. 4, lines 13-19, Ito), and storing the specification into a database on a computer system (col. 5, lines 1-8, Ito).

Regarding claims 2 and 10, all the limitations of these claims have been noted in the rejection of claims 1 and 9 above, respectively. In addition, Ito discloses: wherein the attribute comprises one of a group consisting of the following: a physical attribute of the item; and a functional attribute of the item (col. 4, lines 32-35, Ito).

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Regarding claim 3, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Ito discloses: wherein the specification further includes a virtual area association (col. 5, lines 23-43, Ito).

Regarding claim 4, all the limitations of these claims have been noted in the rejection of claim 1 above. In addition, Ito discloses: further including an item type data structure, including attribute definitions (col. 6, lines 38-61, Ito) and component definitions (col. 6, lines 18-29, Ito).

Regarding claim 7, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Ito discloses: further including an item type defining said data fields for at least one item specification (col. 4, lines 32-42, Ito)..

Regarding claim 8, all the limitations of this claim have been noted in the rejection of claim 1 above. In addition, Ito discloses: further including a schedule definition comprising at least one specification (col. 5, lines 60 to col. 6, lines 17, Ito).

Regarding claim 11, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Ito discloses: wherein the method further includes: storing an item object in the database (col. 5, lines 1-9, Ito); creating a relationship between the item object and the specification; storing the relationship in the database (col. 5, lines 1-9, Ito).

Regarding claim 15, all the limitations of these claims have been noted in the rejection of claim 1 above. In addition, Ito discloses: wherein said step of providing comprises providing a template creation tool ( product model can be prepared by create object view, col. 5, lines 60 to col. 6, lines 17, Ito).

Regarding claim 16, all the limitations of this claim have been noted in the rejection of claim 15 above. In addition, Ito discloses: wherein said step of providing comprises providing a

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specification creation tool ( create construction planning view, col. 5, lines 60 to col. 6, lines 17, Ito).

Regarding claim 17, all the limitations of this claim have been noted in the rejection of claim 15 above. In addition, Ito discloses: wherein said step of providing comprises providing a specification management tool ( management view, col. 6, lines 38-61, Ito).

Regarding claim 18, all the limitations of this claim have been noted in the rejection of claims 1 and 9 above. It is therefore rejected as set forth above.

Regarding claim 19, all the limitations of this claim have been noted in the rejection of claim 18 above. In addition, Ito discloses wherein said step of defining said template comprises: receiving general properties information; and receiving attribute information ( col. 4, lines 8-19, Ito).

Regarding claim 20, all the limitations of this claim have been noted in the rejection of claim 19 above. In addition, Ito discloses wherein said step of defining further includes receiving component information ( col. 4, lines 8-19, Ito).

Regarding claim 21, all the limitations of this claim have been noted in the rejection of claim 25 above. In addition, Ito discloses wherein said step of defining further includes receiving preferences information ( col. 4, lines 8-19, Ito).

Regarding claim 28, all the limitations of this claim have been noted in the rejection of claims 1 and 9 above. It is therefore rejected as set forth above.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**4. Claims 5, 6, 12, 13, 22-25, 27, 30-35, 37, 38 and 41-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (U.S 5761674) provided by Applicant in view of Krause (U.S 5950206) provided by Applicant.**

Regarding claim 5, all the limitations of this claim have been noted in the rejection of claim 1 above. However, Ito didn't disclose: further including at least one history tracking field identifying changes to data in said other fields. On the other hand, Krause discloses: further including at least one history tracking field identifying changes to data in said other fields (col. 5, lines 36-45, Krause). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include the history tracking field identifying changes to data in said other fields in the system of Ito as taught by Krause. The motivation being to enable the system displays each marked construction project for which the related project information changed since the last time the project information database was accessed (col. 3, lines 24-26, Krause).

Regarding claim 6, all the limitations of this claim have been noted in the rejection of claim 5 above. In addition, Ito/Krause discloses: wherein said history tracking field is updated based on a publication process (col. 5, lines 25-35, Krause).

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Regarding claim 12, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Ito/Krause discloses: wherein said step of providing occurs on a first computer and said step of storing occurs on a second computer (col. 4, lines 35-55, Krause).

Regarding claim 13, all the limitations of this claim have been noted in the rejection of claim 12 above. In addition, Ito/Krause discloses: wherein said step of providing includes providing said user data entry interface to a first computer and said step of receiving occurs on a second computer, and said first and second computers are coupled by a network (col. 4, lines 35-55, Krause).

Regarding claim 22, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Ito/Krause discloses: wherein said receiving step includes defining a configurable data object by performing at least one of a group consisting of the following: defining the configurable data object; adding an attribute to the configurable data object; modifying an attribute of the configurable data object; and removing an attribute from the configurable data object (col. 7, lines 1-16, Krause).

Regarding claim 23, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Ito/Krause discloses: wherein the method includes the sub-step of configuring a configurable data object (fig 3 and corresponding text, Krause).

Regarding claim 24, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Ito/Krause discloses: wherein the configurable data object comprises a specification for the item (col. 4, lines 35-62, Krause).



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Regarding claim 25, all the limitations of this claim have been noted in the rejection of claim 9 above. In addition, Ito/Krause discloses: wherein the steps of providing and receiving are performed on a computer coupled to a network (col. 4, lines 35-62, Krause).

Regarding claim 27, all the limitations of this claim have been noted in the rejection of claim 25 above. In addition, Ito/Krause discloses: wherein the step of receiving is performed by receiving data from an item management application provided as part of the data entry interface(fig. 6 and corresponding text, Krause).

Regarding claim 33, all the limitations of this claim have been noted in the rejection of claim 28 above. In addition, Ito/Krause discloses: comprises providing an item specification creation wizard (instruction set 54, fig. 3, Krause).

Regarding claim 35, all the limitations of this claim have been noted in the rejection of claim 25 above Ito/Krause discloses: A system for defining and managing an asset, including a plurality of items associated with the asset, comprising: a data store for item specification data provided (44, fig. 2 and corresponding text, Krause) on a host computer (40, fig. 2 and corresponding text, Krause) coupled to a network (32, fig. 2 and corresponding text, Krause); and a data input toolset (col. 9, lines 39-49, Ito) comprising at least an item specification creation tool, type manager (col. 10, lines 22-35, Ito) and an item specification manager (col. 10, lines 57-57, Ito).

Regarding claims 31 and 38, all the limitations of these claims have been noted in the rejection of claims 28 and 35 above, respectively. In addition, Ito/Krause didn't disclose:

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wherein said step (b) comprises providing an attribute manager. On the other hand, Ito discloses: providing an attribute manager (col. 9, lines 13-24, Ito).

Regarding claims 30 and 37, all the limitations of these claims have been noted in the rejection of claims 28 and 35 above, respectively. In addition, Ito/Krause discloses wherein said step (b) comprises providing an item specification schedule builder (col. 5, lines 25-35, Krause).

Regarding claims 32 and 39, all the limitations of these claims have been noted in the rejection of claims 28 and 35 above, respectively. In addition, Ito/Krause discloses wherein said step (b) comprises providing a component manager (col. 11, 32-37, Ito).

Regarding claim 34, all the limitations of this claim have been noted in the rejection of claim 28 above. In addition, Ito/Krause discloses wherein said step (c) comprises receiving data from the item specification management toolset including one of at least attribute data or component data (col. 9, lines 39-49, Ito).

Regarding claim 41, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: wherein the data store and the data input toolset are provided on the host computer (CAD system, fig. 1, Ito).

Regarding claim 42, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: wherein the data store is provided on the host computer and the data input toolset is provided to a second, client computer (col. 9, lines 39-49, Ito).

Regarding claim 43, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: wherein the toolset is provided by an applications server computer (col. 9, lines 39-49, Ito).

Regarding claim 44, all the limitations of this claim have been noted in the rejection of claim 42 above. In addition, Ito/Krause discloses: wherein the host computer is coupled to the Internet and the data input toolset is provided to a client computer via the Internet (col. 4, lines 35-55, Krause).

Regarding claim 45, all the limitations of this claim have been noted in the rejection of claim 42 above. In addition, Ito/Krause discloses: wherein the host computer is coupled to the Internet and the data store is accessible by a plurality of clients via the Internet (col. 4, lines 35-55, Krause).

Regarding claim 46, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: further including a specification reference tracking facility (col. 5, lines 36-45, Krause).

Regarding claim 47, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: further including a linking facility allowing project participants to link project areas to item specification data (col. 5, lines 65 to col. 6, lines 8, Krause).

Regarding claim 48, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: further including a permissions facility regulating the actions of project participants with respect to item specification data in the data store (col. 4, lines 63 to col. 5, lines 18, Krause).

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Regarding claim 49, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: further including an approval routing tool based on a publication of at least one item specification (col. 4, lines 63 to col. 5, lines 18, Krause).

Regarding claim 50, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: further including a notification tool linked to specific actions affecting data in the data store (col. 5, lines 36-45, Krause) and providing notifications to project participants when specific actions occur as defined by a user set business rules (col. 12, lines 55-58, Ito).

Regarding claim 51, all the limitations of this claim have been noted in the rejection of claim 35 above. In addition, Ito/Krause discloses: further including a history tracking system tracking changes to data in the data store (col. 5, lines 36-45, Krause).

**5. Claims 14, 26, 29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito (US 5761674) in view of Krause (U.S 5950206) provided by Applicant and in view of Bentley et al. (U.S 6063128) (Bentley).**

Regarding claims 14 and 26 , all the limitations of these claims have been noted in the rejection of claims 13 and 25 above, respectively. However, Ito/Krause didn't disclose: wherein the network is the Internet. On the other hand, Bentley discloses: wherein the network is the Internet (col. 50, line 49-60, Bentley). Thus, at the time invention was made, it would have been obvious to a person of ordinary skill in the art to include network is the Internet in the combination system Ito/Krause of as taught Bentley. The motivation being enable the system connect to the Internet to publish the manufacture web site so anyone can access in the web site.

Regarding claims 29 and 36, all the limitations of these claims have been noted in the rejection of claims 28 and 35 above, respectively. In addition, Ito/Krause/Bentley discloses wherein said step (b) comprises providing an item specification publisher (col. 48, lines 38-55, Bentley).

#### **6. Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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### **7. Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

CN

Cindy Nguyen  
December 2, 2004

  
FRANTZ COBY  
PRIMARY EXAMINER